REMARKS

Claims 1-16, 18-33 and 35 are pending in the application and have been rejected. Applicant has amended Claim 1 to more clearly point out the present inventive concept.

I. Claim Rejections – 35 U.S.C. § 103

A. Combination of *Hudetz*, *Nelson*, *Russell*, and *Wellner*

Claims 1-12, 16-18, 19-30, 33, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5, 978, 733 to *Hudetz et al.* (hereinafter "*Hudetz*"), U.S. Patent No. 6,297,727 to *Nelson* (hereinafter "*Nelson*" and U.S. Patent No. 5,905,248 to *Russell et al* (hereinafter "*Russell*"). Claims 13-15 and 31-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Hudetz-Nelson-Russell* combination and further in view of U.S. Patent No. 5,640,193 to *Wellner* (hereinafter "*Wellner*"). These rejections are respectfully traversed with respect to the claims as currently presented.

Applicant submits that the proposed primary combination of *Hudetz* and *Nelson* is flawed. For example, *Hudetz* describes various scenarios in which a barcode may be scanned from "ordinary articles of commerce" (*see, e.g.*, Abstract). However, if combined with the RFID system of *Nelson*, there is no teaching or suggestion as to how a particular barcode would be scanned if multiple barcodes are in range. In other words, if each article of commerce contains a barcode as proposed by *Hudetz*, how will the RFID system of *Nelson* recognize which particular code is desired by a user for scanning? How would a user choose a particular barcode? In *Hudetz*, such differentiation between various barcodes that are in close proximity is not required other than by scanning of the proper barcode by the user.

Applicant submits that one skilled in the art would not be motivated to combine the two systems of *Hudetz* and *Nelson*, each of which performs a specific function in order to fulfil a specific purpose, because such a combination would not result in an advantage to either system. *Hudetz* has no need for "expanding the required proximity of the device" as stated in paragraph 37 of the Office Action because a user is personally selecting a particular barcode and has no need for expanded proximity. *Nelson*'s RFID has no need of *Hudetz*'s passive tag as that defeats

the purpose of the invention of *Nelson*. Accordingly, Applicant submits that one skilled in the art would not be motivated to combine the *Buckley* and *Schmitt* references as described in the Office Action.

With respect to specific language in the Office Action, *Hudetz* is directed to a passive device (i.e., a barcode). As admitted in the Office Action, *Hudetz* fails to disclose the element of Claim 1 that recites "when the portable triggering device is within a predetermined proximity of an activation system, the activation system interacting with the triggering device causing the unique code from the triggering device to be extracted therefrom through activation thereof, the activation system interfaced with a network and physically separate from the triggering device…." The Office Action then relies on the RFID system of *Nelson* to remedy this deficiency of the passive barcode system of *Hudetz*. To support this combination, the Office Action states that "*Hudetz* suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature (Figure 8, column 6, lines 28-33, column 7, lines 17-28, column 12, lines 11-21)." However, as described below, Applicant submits that the cited paragraphs fail to suggest the combination of *Hudetz*'s passive system with the RFID system of *Nelson*.

> UPC symbol 46 provides a machine-readable number that uniquely identifies a particular product and its manufacturer. This is useful at the retail point-of-sale, where purchase of a particular item is recorded by scanning the item's bar code symbol. (*Hudetz*, column 6, lines 28-33)

The first cited paragraph as reproduced above simply describes a use for a passive UPC symbol.

> Each record 62-68 of database 60 associates a UPC product identification number (contained in fields 70 and 72) with a particular Internet URL and narrative description (contained in fields 74 and 76, respectively). The association is based on selected criteria. In this case, the criteria is the existence of a Web resource sponsored by the manufacturer of the product identified by the

> UPC number in fields 70 and 72. (If no such resource exists, then the particular product identifier can be omitted from database 60). Other criteria can be used. For example, the association could be based on the existence of a Web site simply referring to or relating to the product. (*Hudetz*, column 7, lines 17-28)

The second cited paragraph as reproduced above simply describes associating a passive UPC product identification number with information in a database. The criteria upon which the associations are based may change, but the UPC product identification number is still represented by a passive device.

> The foregoing embodiment is just one example. Many alternatives are possible. For example, in lieu of a bar code scanning device, a card reader could be employed. The card reader would read a magnetic stripe affixed to a card or other printed matter. The card would contain human-readable information about a network resource, and the magnetic strip would contain the resource's numeric or mnemonic address in machine-readable format. Alternatively, a RF data collection scanner or CCD scanning system could be used. Bar code symbol 126 could also be associated with specific commands such as "forward", or "back," or command sequences used to access information. (*Hudetz*, column 12, lines 11-21)

While the third cited paragraph as reproduced above describes alternatives, these alternatives are all passive. Both the RF data collection scanner (i.e., an extender device that scans a barcode using conventional scanning methods and then transmits the scanned information via an RF signal rather than a cable) and the CCD scanning system deal with passive codes that must be scanned as described elsewhere in *Hudetz*.

Accordingly, Applicant submits that even if the cited paragraphs of *Hudetz* suggest exploration of art and/or provide a reason to modify the method with the portable triggering device feature, such suggestions are limited to passive systems as described in *Hudetz*.

In other words, as recognized in the Office Action, the passive tag of *Hudetz* does not and cannot interact or be activated as required by Claims 1 and 19. Therefore, the RFID of *Nelson* is substituted in the Office Action for the passive tag of *Hudetz*. The Office Action further states in paragraph 37 that "the general barcode system of *Hudetz* is limited by the required proximity of the triggering device with the activation system and by the need for user activation of the system. *Nelson*'s RFID remedies this deficiency by using RF signals to remotely transmit coded information expanding the required proximity of the device." However, nowhere does *Hudetz* indicate that it would be desirable to expand the "required proximity" of the passive device. In fact, *Hudetz* discloses in column 12, lines 11-21, an RF data collection scanner (i.e., an extender device that scans a barcode using traditional scanning methods and then transmits the scanned information via an RF signal rather than a cable) that replaces a cable connecting the scanner to the remainder of the system but provides no teaching or suggestion for increasing the proximity of the passive device itself. In fact, as stated previously, Applicant submits that such an expanded proximity may actually complicate the operation desired in *Hudetz* without providing any advantages, as a user may have to somehow distinguish between multiple barcodes rather than simply scan the desired barcode without gaining any benefit from the expanded proximity. Accordingly, Applicant submits that it would not be obvious for one skilled in the art to integrate the RFID of *Nelson* with the passive device of *Hudetz*. The remaining references do not remedy these deficiencies of the *Hudetz* and *Nelson* combination.

Therefore, Applicant submits that independent Claims 1 and 19 are allowable over the cited references. The remaining claims depend from Claims 1 and 19 and are allowable for at least the same reasons as Claims 1 and 19.

B. Combination of *Buckley* and *Schmitt*

Claims 1-4, 8, 9, 10-11, 16, 18-22, 24, 26, 28-29, 33 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,446,871 to *Buckley et al.* (hereinafter "*Buckley*") and U.S. Patent No. 5,903,22 5 to *Schmitt et al.* (hereinafter "*Schmitt*").

Applicant submits that the proposed combination of *Buckley* and *Schmitt* is flawed. For example, *Buckley* describes various scenarios in which a barcode may be scanned from various surfaces of a periodical (see, e.g., column 4, lines 41-47). However, even if combined with the

system of *Schmitt*, there is no teaching or suggestion as to how a particular barcode would be scanned. If each article or advertisement in a periodical contains such a code as proposed by *Buckley*, how will the "access triggering device" of *Schmitt* recognize which particular code is to be scanned if there are multiple codes within range?

Applicant submits that one skilled in the art would not be motivated to combine the two systems of *Buckley* and *Schmitt*, each of which performs a specific function in order to fulfil a specific purpose, because such a combination would not result in an advantage to either system. *Buckley* has no need to eliminate the scanner by having the triggering device automatically communicate with the activation system and has no need to prevent a user from going through the inconvenience of locating or manipulating the scanning system as proposed in the Office Action (page 11), because the invention described in *Buckley* "facilitates a user's ability to retrieve information on the Internet or other broad-based computer communication network using an altered version of a commonly-carried writing instrument." (*Buckley*, column 3, line 67 – column 4, line 3). In other words, *Buckley* alleviates these issues by presenting the various embodiments described therein, most notably as an easily portable pen. In fact, such automatic communication may be disadvantageous to a user when multiple barcodes are present or when the user does not want to scan a barcode, and such automatic communication may be prevented by requiring the user to scan the barcode as described in *Buckley*. *Schmitt* has no need of *Buckley*'s barcode scanning system, as *Schmitt* incorporates a fingerprint scanner and an access triggering device in a system (see, e.g., *Schmitt*, Abstract) that has no need to distinguish between closely located barcodes such as are found in the periodicals of *Buckley*. Accordingly, Applicant submits that one skilled in the art would not be motivated to combine the *Buckley* and *Schmitt* references as described in the Office Action.

With respect to specific language in the Office Action, *Buckley*, like *Hudetz* in the previous section, is directed to a passive device. As admitted in the Office Action, *Buckley* fails to disclose "a portable *triggering* device having a unique code stored therein and causing extraction of the unique code from the triggering device with an activation system operable to interface with the portable triggering device *when the portable triggering device is proximate to the activation system*." (Emphasis original) The Office Action then relies on the access triggering device (i.e., a passive transponder) of *Schmitt* to remedy this deficiency of the passive

device of *Buckley*. To support this combination, the Office Action states that "*Buckley* suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as wireless and portable triggering device (column 4, lines 56-61, column 5, lines 49-55, column 11, lines 27-37, column 12, lines 52-58)." However, as described below, Applicant submits that the cited paragraphs fail to suggest the combination of *Buckley*'s passive system with the access triggering device of *Schmitt*.

> Alternatively, the pen can communicate directly with the computer. In other words, no physical connection, e.g., no data well, is used. Instead wireless communication technology, such as an infra-red link or other electromagnetic link, is used to allow the pen to communicate directly with a computer. (*Buckley*, column 4, lines 56-61)

The first cited paragraph as reproduced above describes means by which the pen (i.e., the scanner) can communicate with the system. This text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

> Alternatively, the data reader 16 can communicate directly with a personal computer using wireless communication technology, e.g., a radio-frequency (RF) link, an infrared link, or other electromagnetic link, as described further below. In other words, circuits in the data reader both read the code associated with an article and communicate with a personal computer or other electronic device. (*Buckley*, column 5, lines 49-55)

The second cited paragraph as reproduced above again describes means by which the data reader (i.e., the scanner) can communicate with the system. As with the first cited paragraph, this text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

> In embodiments of the present invention described above, a code reader is incorporated into a pen. In other embodiments, the code

> reader may be incorporated in other writing instruments, or may be incorporated in some other, preferably portable, device such as a watch, cellular phone, etc. In still other embodiments, the code reader may be a stand-alone portable device designed to easily fit within a pocket or brief case and may be even incorporated into a laser-pointer-type shaped device which may be attached to a user's keychain. (*Buckley*, column 11, lines 27-37)

The third cited paragraph as reproduced above simply describes different physical embodiments of the code reader. As with the two previously cited paragraphs, this text does not describe any type of communication between the object being scanned (i.e., a barcode) and the scanner.

> Having thus described at least one illustrative embodiment of the invention, various alterations, modifications and improvements will readily occur to those skilled in the art. Such alterations, modifications and improvements are intended to be within the scope and spirit of the invention. Accordingly, the foregoing description is by way of example only and is not intended as limiting. (*Buckley*, column 12, lines 52-58)

The fourth cited paragraph as reproduced above simply states that "various alterations, modifications and improvements" may be made, but fails to actually suggest any such modifications, much less one that would involve a triggering device as required by Claims 1 and 19.

Accordingly, Applicant submits that even if the cited paragraphs of *Buckley* suggest exploration of art and/or provide a reason to modify the method with the a triggering device feature, such suggestions are limited to passive systems as described in *Buckley*.

In other words, as recognized in the Office Action, the passive tag of *Buckley* does not and cannot interact or be activated as required by Claims 1 and 19. Therefore, the access triggering device of *Schmitt* is substituted in the Office Action for the passive tag of *Buckley*.

The Office Action (page 11) further states that "[i]t would have been obvious to one of ordinary skill in the art … to modify the method and apparatus of *Buckley* with the teachings of *Schmitt* to include a portable triggering device of a user having a unique code stored therein in order to eliminate the cumbersome scanner because the triggering device would communicate with the activation system automatically when the user is in contact with the activation system…. In addition, the portable triggering device would prevent the users [from going] through the inconvenience of locating or manipulating the scanner system." However, nowhere does *Buckley* indicate that such modifications are desirable. In fact, as described previously, *Buckley* describes in detail various embodiments that alleviate such concerns, and such modifications may actually complicate the operation desired in *Buckley* without providing any advantages.

Therefore, Applicant submits that independent Claims 1 and 19 are allowable over the cited references. The remaining claims depend from Claims 1 and 19 and are allowable for at least the same reasons as Claims 1 and 19.

II. Request for Interview

Applicant specifically requests that an interview be granted with respect to the combinations discussed above. As Applicant has described, one skilled in the art would not be motivated to combine the references as required in the Office Action due to complications that such combinations would create for the systems involved. More specifically, the deficiencies of the *Hudetz* and *Buckley* references identified in the Office Action are not actually deficiencies and attempting to remedy them as suggested in the Office Action would introduce problems in their operation rather than improvements by forcing functionality that interferes with the intended operation of the systems described therein.

III. Conclusion

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/RPXC-25,356 of HOWISON & ARNOTT, L.L.P.

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January 11, 2010